

### **REMARKS**

This is a full and timely response to the outstanding non-final Office Action mailed September 10, 2004 (Paper No. 20040901). Upon entry of this response, claims 2-4, 10-16, and 35-54 are pending in the application. In this response: claims 35-54 have been added; claims 1, 5-9, and 17-34 have been cancelled; and claims 2-4, 10, 11, and 14-16 have been amended. Applicants respectfully request that the amendments being filed herewith be entered and request that there be reconsideration of all pending claims.

1. **Examiner Interview**

A telephone interview between Examiner Ouellette and Applicants' representatives (Jeff Kuester and Karen Hazzah) took place on September 28, 2004. During the interview, the parties discussed: the § 101 rejection of claims 1, 11, and 26; the § 102 rejection of claims 4, 11, 19, and 26; and the § 103 rejection of claims 5-10. Examiner Ouellette suggested possible claim structures to overcome the § 101 rejection, and also explained his position on the meaning of the claim term "intellectual property." Applicants wish to thank Examiner Ouellette for his time.

2. **In-Person Examiner Interview**

A second, in-person interview took place on December 16, 2004. The attendees were Examiner Jonathan Ouellette, Supervisory Examiner John Weiss, Applicants' representative Jeff Kuester, and inventor Scott Frank. The parties discussed general aspects of the § 101 rejection, references of record, and potential claiming considerations. Applicants wish to thank Examiner Ouellette and Supervisory Examiner Weiss for their time.

3. Newly Added Claims

Applicants respectfully submit that new claims 35-54 are allowable over the cited references. Specifically, independent claim 35 is allowable for at least the reason that the cited references do not teach, disclose, or suggest the feature of “generating an assessment of the marketability of the intellectual property asset based at least in part on the intellectual property asset data and on a criterion, wherein the criterion includes *whether marketing the intellectual property asset to a customer will have a non-royalty impact on a marketer of the intellectual property asset.*” Independent claim 41 also includes an element related to generating an assessment of the marketability of the intellectual property asset based at least in part on the intellectual property asset data and on a criterion, wherein the criterion includes *whether marketing the intellectual property asset to a customer will have a non-royalty impact on a marketer of the intellectual property asset.*

Independent claim 48 is allowable for at least the reason that the cited references do not teach, disclose, or suggest the feature of “determining a marketing opportunity assessment for the intellectual property asset *based at least in part on the determined market potential assessment, the marketing project timeframe assessment, the projected revenue potential assessment, and the competitive threat assessment.*” Therefore, Applicants request the Examiner to enter and allow the above new claims.

4. Rejection of Claims 1, 11, and 26 under 35 U.S.C. § 101

Claims 1, 11, and 26 have been rejected under § 101 as allegedly being directed to non-statutory subject matter. Claims 1 and 26 have been cancelled, and thus the rejection of claims 1 and 26 is moot. Claim 11 has been amended to recite “determining, utilizing a computer system, a market potential assessment for the intellectual property asset.” Applicants respectfully submit

that the amendment overcomes the rejection of claim 11 under § 101, and request that the rejection be withdrawn.

5. Rejection of Claims 1-4, 11-13, 19-21, and 26-28 under 35 U.S.C. § 102

Claims 1-4, 11-13, 19-21, and 26-28 have been rejected under § 102(e) as allegedly anticipated by *Asplen, Jr.* (U.S. 6,044,354). Applicants respectfully submit that these rejections are rendered moot by claim cancellation, or are overcome by claim amendments made herein or discussions below. A proper rejection of a claim under 35 U.S.C. § 102 requires that a single prior art reference disclose each element of the claim. *See, e.g., W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983).

a. Claims 1-4, 19-21, and 26-28

Claims 1-4, 19-21, and 26-28 have been cancelled, and therefore the rejection is moot. Applicants take this action merely to reduce the number of disputed issues and to facilitate early allowance and issuance of other claims in the present application. Applicants reserve the right to pursue the subject matter of these cancelled claims in a continuing application, if Applicants so choose, and do not intend to dedicate any of the cancelled subject matter to the public.

b. Claim 11

Applicants respectfully submit that claim 11, as amended, is allowable for at least the reason that *Asplen, Jr.* does not disclose, teach, or suggest at least the feature of “determining, utilizing a computer system, a market potential assessment for the intellectual property asset.” *Asplen, Jr.* discloses a product planning system including evaluation of a product idea. The system in *Asplen, Jr.* also supports input of new product ideas. However, Applicants respectfully submit that new product ideas are not equivalent to “intellectual property,” and therefore the

evaluation of a product idea is not equivalent to “a market potential assessment for the intellectual property asset.”

Furthermore, Applicants respectfully submit that claim 11, as amended, is allowable for at least the reason that *Asplen, Jr.* does not disclose, teach, or suggest at least the feature of “determining a marketing project timeframe assessment for the intellectual property asset; and determining a marketing opportunity assessment for the intellectual property asset based at least in part on...the ***marketing project timeframe assessment***.”

The Office Action does not allege specific portions of *Asplen, Jr.* that disclose this feature. FIG. 2 depicts a menu listing “market assessment.” This menu choice is not discussed in the text of *Asplen, Jr.*, and the “opportunity assessment” of FIG. 2 is described only in general terms: “This chapter establishes the feasibility of the product from a technological, market and strategic perspective.” (Col. 3, lines 51-53.) Applicants respectfully submit that neither the “opportunity assessment” described in that passage, or the menu listing “market assessment” in FIG. 2, is equivalent to “a marketing project timeframe assessment” as recited in claim 11.

Furthermore, *Asplen, Jr.* does not disclose “timeframes” of any kind. Even assuming, *arguendo*, that the “assessments” referred to in *Asplen, Jr.* correspond to the claimed “marketing project timeframe assessment,” the reference merely teaches that each stage or chapter of product development includes certain tasks. It does not disclose a timeline, timeframe, or schedule associated with these tasks.

For at least the reason that *Asplen, Jr.* fails to disclose, teach or suggest the above-described features recited in amended claim 11, Applicants respectfully submit that *Asplen, Jr.* does not anticipate claim 11. Therefore, Applicants request that the rejection of claim 11 be withdrawn.

c. Claims 12 and 13

Since claim 11 is allowable, Applicants respectfully submit that claims 12 and 13 are allowable for at least the reason that each depends from an allowable claim. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988). Therefore, Applicants respectfully request that the rejection of claims 12 and 13 be withdrawn.

6. Rejection of Claims 5-10, 14-18, 22-25, and 29-34 under 35 U.S.C. § 103

Claims 5-10, 14-18, 22-25, and 29-34 have been rejected under § 103(a) as allegedly obvious over *Asplen, Jr.* (U.S. 6,044,354). Applicants respectfully submit that these rejections are rendered moot by claim cancellation, or are overcome by claim amendments made herein or discussions below.

a. Claims 5-9

Claims 5-9 have been cancelled, and therefore the rejection is moot. Applicants take this action merely to reduce the number of disputed issues and to facilitate early allowance and issuance of other claims in the present application. Applicants reserve the right to pursue the subject matter of these cancelled claims in a continuing application, if Applicants so choose, and do not intend to dedicate any of the cancelled subject matter to the public.

b. Claim 10

Claim 10 has been amended to depend from newly added claim 35. Applicants respectfully submit that these amendments overcome the rejection, and request that the rejection of claim 10 be withdrawn.

c. Claims 14-18

In the rejection of claims 14-18, the Office Action states that the claimed elements are “only found in the nonfunctional descriptive material and are not functionally involved in the steps recited.” (Office Action, p. 8, paragraph 24.) Applicants have amended claims 14-16 so that the elements introduced by these dependent claims are each recited as a step. Applicants respectfully submit that these amendments overcome the rejection of claims 14-16. Furthermore, claims 17 and 18 have been cancelled, so the rejection of claims 17 and 18 is rendered moot. Applicants therefore request the rejection of claims 14-18 be withdrawn.

d. Claims 22-25 and 29-34

Claims 22-25 and 29-34 have been cancelled, and therefore the rejection is moot. Applicants take this action merely to reduce the number of disputed issues and to facilitate early allowance and issuance of other claims in the present application. Applicants reserve the right to pursue the subject matter of these cancelled claims in a continuing application, if Applicants so choose, and do not intend to dedicate any of the cancelled subject matter to the public.

**CONCLUSION**

Applicants respectfully request that all outstanding objections and rejections be withdrawn and that this application and presently pending claims 2-4, 10-16, and 35-54 be allowed to issue. Although some dependent claim rejections and some obviousness rejections are explicitly addressed above, the omission of arguments for other claims is not intended to be construed as an implied admission that the Applicants agree with the rejection or finding of obviousness for the respective claim or claims. If the Examiner has any questions or comments regarding Applicants' response, the Examiner is encouraged to telephone Applicants' undersigned counsel.

Respectfully submitted,

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& RISLEY, L.L.P.**

By: 

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